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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,707	05/16/2005	Toshio Ohkoshi	2005-0686A	8685
513 7590 07/11/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER PARKER, FREDERICK JOHN				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,707

Applicant(s)

OHKOSHI ET AL.

Examiner

Frederick J. Parker

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-83 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 38-83 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/55/08)
Paper No(s)/Mail Date 5/13/05:11/19/07
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title is generic and not reflective of the invention.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 38,42,43,57,60,61,70,71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - Claim 38 is vague and indefinite because the meaning of “base paint powders” is unclear, and could be either an organic carrier or pigment since each forms a critical basis of a powder paint.
 - Claims 42, 43 are vague and indefinite because the relative term “bright” does not convey the intended reflectivity or color brilliance of the pigment.
 - Claims 57,60,61,70,71 are vague and indefinite because the word “type” unclearly extends the scope of a definite expression so as to render it indefinite, Ex parte Copenhaver 109 USPQ 118.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 38 is rejected under 35 U.S.C. 102(b) as being anticipated by Mizoguchi US 4260424.

A pigment composition which specifically includes pigmented powder paint is characterized by the presence of a pigment and suitable resins including shellac, melamine, polyesters, etc which form the resin base such that at least some pigment particles are inherently bound by shellac. Col. 1, 60 to col. 2, 41.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
10. Claims 39-54,58-64,68-74, 78-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizoguchi US 4260424 in view of EP 1 134 264 ("EP'264") . Mizoguchi US 4260424 is cited for the same reasons previously discussed which are incorporated herein. Details of the formulation and its use are not stated.

EP'264 teaches a powder coating paint composition in which inorganic metallic pigment flakes (1-100 microns length and 0.01-5 microns thick per claims 41-45); the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made if the overlapping portion of the pigments properties disclosed by the reference were selected because overlapping ranges have been held to be a prima facie case of obviousness, see In re Wortheim 191 USPQ 90. The teaching suggests any platy pigment material comprising a metal including those that are luminescent (clm 46) as they would have been obvious modifications within the purview of one skilled in the art, with a predictable outcome. Pigment flakes contents range between 1-20 pp Wt which overlaps the range of claim 47. The powder comprises metallic flakes adhered to or mixed with at least one thermosetting base powder, e.g.

acrylic, polyester, epoxy, etc without further limitation (and therefore inclusive of those of Applicants' specific hardening types claims 60-63) [007-012] having a particle size of 5-100 microns [0013] per claim 40. Specific ratios of thermosetting materials which can be used are not limited, and since Mizoguchi similarly teaches shellac as a powder useful in such powder paints, the amounts for formulations would have been determined by one of ordinary skill for any specific end use, as recognized by Mizoguchi, col. 2, 33-36 and elsewhere in the references, per claim 39. [040] teaches such powders are applied to metal substrates by electrostatic powder spraying, followed by the application of a clear resinous topcoat of a similar thermoset resin.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Mizoguchi by incorporating the specifics of the formulation and electrostatic coating thereof of the similar method of EP'264 because of the expectation and predictability of successfully applying the pigmented powder coating having excellent metallic luster.

As to product by process claims 74, 78-83, given the lack of specific structure for the coating of the claims, and the similarity of the methods, the product of the claims and prior art would have been essentially the same or only slightly different, and therefore would not patentably distinguish over the art of the prior art. The patentability of a product is based upon the product itself as claimed, and not upon its method of production. If the product of a product-by-process claim is the same or obvious from a product of the prior art, it is unpatentable even though the processes of making may be different. It is the burden of Applicant to establish an unobvious difference between the claimed product and that of the prior art, MPEP 2113.

As to the method of making the powder paint, the Examiner notes that EP'264 recognizes that ingredients added to a pigmented powder tend to deposit the added pigment to the surface of the resin [006] so that the presence of shellac with resin as taught by Mizoguchi would have necessarily provided the same benefit. As to making the powder paint formulation, EP'264 in [017-041], the mixture of powders and addition of liquids in desired order and proportions as determined by routine experimentation and using commonly utilized and known powder forming apparatus simply represents an obvious process well within the purview of one skilled in the art. A process may be obvious when considered as a whole, notwithstanding that the specific starting material or product is not present in the prior art, In re Durden 226 USPQ 359. In re Rose and others 105 USPQ 237 settles that changes in size, degree, shape, proportions, and sequence of adding formulation ingredients are obvious variations. Thus, even if the starting material or product were to eventually be found unobvious, the use of common means and techniques to produce it would still be obvious. In the instant case, Graham v. Deere analysis of the method of making ascertains that the level of skill in this particular area of the art is very low: a BS degree or technical experience, based upon the Examiner's 19 years of powder/materials research prior to being an Examiner. Thus claims 48-53 simply represent obvious modifications of what is generally disclosed by the prior art and apparent to one of ordinary skill, and is not patentably distinct.

11. Claims 55-57,65-67,75-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizoguchi US 4260424 in view of EP 1 134 264 ("EP'264") alone, or further in view of Dattilo US 6291018.

Mizoguchi US 4260424 and EP'264 are cited for the same reasons previously discussed, which are incorporated herein. Use of a primer layer is not stated; however, it is the Examiner's position that the application of a suitable primer layer to any surface, including a metal, prior to application of a coating is a notoriously conventional step to improve adherence between a coating and substrate. Nonetheless, the Examiner introduces Dattilo, col. 2, 29-40 which teaches the conventionality of a primer layer on substrates including metals prior to electrostatic coating.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mizoguchi US 4260424 in view of EP 1 134 264 by applying a primer layer to the metal substrate as known in the art, optionally shown by Dattilo, to provide the known and predictable benefit of improving adhesion of the coating to the substrate.

As to product by process claims 75-77, given the lack of specific structure for the coating of the claims, and the similarity of the methods, the product would have been essentially the same or only slightly different, and therefore would not patentably distinguish over the art of the prior art. The patentability of a product is based upon the product itself as claimed, and not upon its method of production. If the product of a product-by-process claim is the same or obvious from a product of the prior art, it is unpatentable even though the processes of making may be different. It is the burden of Applicant to establish an unobvious difference between the claimed product and that of the prior art, MPEP 2113.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection

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is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

13. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b). Claims 38, 39, 54, 64, 74 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12, 14, 15 of copending Application No. 11/666876. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 merely cites "powder coating materials" (elsewhere exemplified to be pigments), which is generic to include "pigment particles" and therefore an obvious variation.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner
Art Unit 1792

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